

REMARKS/ARGUMENT

This Amendment is being filed in response to the Office Action dated June 20, 2005. Reconsideration and allowance of the application in view of the amendments made above and the remarks to follow are respectfully requested.

Claims 1-19 are pending in this application. Claims 1, 15, 18, and 19 are independent claims.

The Applicants would like to thank the Examiner for the indication that Claims 1, 2, 5, and 8-14 are allowed. Further, Claim 17 is indicated as allowable if amended to be in independent form including limitations of a base and intervening claims.

In the Office Action, Claim 18 is rejected under 35 U.S.C. §101 for being directed to non-statutory subject matter. Without accepting this position asserted by the Examiner, Claim 18 is amended herein to include the suggested claim language. Accordingly, it is respectfully submitted that Claim 18 comports with the suggestion made by the Examiner. Accordingly, removal of this ground of rejection is respectfully requested.

Claims 15, 16, 18, and 19 are rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,917,553 to Honey ("Honey '553") in view of U.S. Patent No. 6,230,204 to Fleming ("Fleming"). These rejections are respectfully traversed.

In response to the above rejections, the following general remarks are presented as applicable for the rejections indicated above. It is the Applicants' position that this combination of Honey '553 with Fleming is as first matter, improper, and as a second matter, even in combination does not disclose or suggest the claimed subject matter.

It is respectfully submitted that for each of the above rejection, the Office Action cites a motivation to make combinations of references that finds no support in the cited references.

With regard to the rejection of Claims 15, 16, 18, and 19 under 35 U.S.C. §103 as being obvious over Honey '553 in view of Fleming, the Office Action states that (emphasis provided) "[i]t would have been obvious to one having ordinary skills in the art at the time the invention was made to ensure viewing time in the system of Honey. An efficient method of estimating usage activity would have been a desirable feature in video broadcasting art to its production function and Fleming recognizes efficient estimation of usage activity would be expected when ensuring viewing time to advertisers is included in Honey ['553]".

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of

obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1442, 1444 (Fed. Cir. 1992). See also In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art of knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

When determining obviousness, "[t]he factual inquiry whether to combine references must be thorough and searching." In re Lee, 277 f.3d 1338, 1343, 61 USPQ 1430, 1433 (Fed. Cir. 2002), citing McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). "It must be based on objective evidence of record." Id. "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617. "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." Dembiczak, 175 F.3d at 1000, 50 USPQ2d at 1617, citing McElmurry v. Ark. Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

The suggestion in the Office Action that the combinations of prior art references "would be obvious to one having ordinary

skills in the art ... " is respectfully refuted. One may not utilize the teachings of the present application as a road map to pick and choose amongst prior art references for the purposes of attempting to arrive at the presently disclosed invention. The Federal Circuit has identified three possible sources for motivation to combine references including the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. (See, *In re Rouffet*, U. S. Court of Appeals Federal Circuit, U.S.P.Q. 2d, 1453, 1458.) There must be a specific principle that would motivate a skilled artisan, with no knowledge of the present invention, to combine the prior art as suggested in the Office Action. The use of hindsight in the selection of references is forbidden in comprising the case of obviousness. Lacking a motivation to combine references, a proper case of obviousness is not shown (see, *In re Rouffet*, 1458).

The U.S. Court of Appeals for the Federal Circuit (the "Federal Circuit") restated the legal test applicable to rejections under 35 U.S.C. § 103(a) in the *In re Rouffet*, holding. The Court stated:

[V]irtually all [inventions] are combinations of old elements. Therefore an Examiner may often find every element of a claimed invention in the prior art.

Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." To prevent the use of hind sight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. The Board [of Appeals] did not, however, explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. ... To counter this potential weakness in the obviousness construct **the suggestion to combine requirements stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.**

In re Rouffet, 47 USPQ2d 1457-58 (Fed. Cir., July 15, 1998) (citations omitted, emphasis added).

More recently, the Federal Circuit again dealt with what is required to show a motivation to combine references under 35 U.S.C. § 103(a). In this case the court reversed the decision of the Board of appeals stating:

[R]ather than pointing to specific information in Holiday or Shapiro that suggest the combination..., the Board instead described in detail the similarities between the Holiday and Shapiro references and the claimed invention, noting that one reference or the other-in combination with each other... described all of the limitations of the pending claims. Nowhere does the Board particularly identify any suggestion, teaching, or motivation to combine the ... references, nor does the Board make specific-or even inferential-findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any factual

findings that might serve to support a proper obviousness analysis.

In re Dembiczak, 50 USPQ2d 1614, 1618 (Fed. Cir., April 28, 1999) (citations omitted).

Thus, from both *In re Rouffet* and *In re Dembiczak* it is clear that the Federal Circuit requires a specific identification of a suggestion, motivation, or teaching why one of ordinary skill in the art would have been motivated to select the references and combine them.

The Examiner's reasoning for the motivation, namely, that those skilled in the art would have been motivated to combine Honey '553 with Fleming because "it would have been a desirable feature ...", could only have been made with hindsight based on the teachings of the present disclosure. The Examiner's reasoning for the motivation for combining the references is nowhere recognized in the prior art nor does the Examiner attempt to make any showing that the art recognized such problems.

Where a feature is not shown or suggested in the prior art references themselves, the Federal Circuit has held that the skill in the art will rarely suffice to show the missing feature. Al-Site Corp. v. VSI International Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (Rarely, however, will the skill in the art

component operate to supply missing knowledge or prior art to reach an obviousness judgment).

Thus, Applicants again respectfully submit that the Examiner has used impermissible hindsight to reject claims 15, 16, 18, and 19 under 35 U.S.C. § 103(a). As discussed above, the Federal Circuit in *In re Rouffet* stated that virtually all inventions are combinations of old elements. Therefore an Examiner may often find every element of a claimed invention in the prior art. To prevent the use of hindsight based on the invention to defeat patentability of the invention, the Examiner is required to show a motivation to combine the references that create the case of obviousness. Applicants respectfully submit that the Examiner has not met this burden by stating that "it would have been desirable ...".

The mere fact that the prior art device could be modified so as to produce the claimed device, which even in combination Honey '553 in view of Fleming does not, is not a basis for an obviousness rejection unless the prior art suggested the desirability of the modification. See, *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984); and *In re Laskowski*, 871 F.2d 115, 117 (Fed. Cir. 1989).

The only suggestion that can be found anywhere for making these combinations appears to come from the present patent application itself.

How can the Office Action espouse that this reconstruction forwarded does not include knowledge gleamed only from the applicant's disclosure? If this reconstruction did not come from the present application, where did it come from? The above reconstruction certainly did not come from the prior art. Even the Office Action does not point to any portions of the prior art for teaching the suggestion reconstructions/modification as pointed out above. It is not sufficient to merely say that a modification is "desirable" and therefore obvious. Where do the references indicate this desirable modification???

In consideration of the use of improper hindsight for rendering a claim obvious in light of prior art, the Federal Circuit has stated that "to draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction - an illogical and inappropriate process by which to determine patentability." (Sensonics, Inc. v. Aerosonic Corp., 81 F.3d 1566, 38 USPQ2d 1551 (Fed. Cir. 1996). "To imbue one of ordinary skill in the art with knowledge of the invention ensued, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught

is used against its teacher." (In re Zurko, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997). "A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field (cited reference omitted). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher (cited references omitted).'" (In re Kotzab, 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000).

The applicants respectfully maintain that there is no suggestions in the prior art references to make the combinations in the manner proposed by the Examiner to achieve the applicants' claimed invention.

The Examiner is requested to consider MPEP 2143, wherein it is stated:

"THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION ... The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be

found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." And, "FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH PRIMA FACIE OBVIOUSNESS ... The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)... Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.)"

It is respectfully submitted that in light of the state of the law as set forth by the Federal Circuit and the Examiner's lack of specificity with regard to the motivation found to combine the cited references, that the suggested combination of prior art utilized to reject each of Claims 1-6, 10, and 14-18 finds proper motivation for combination. Further, since the Office Action acknowledges that the prior art alone does not show the claimed features, it is respectfully requested that Claims 15, 16, 18, and 19 be allowed and an indication to that effect is respectfully requested.

With regard to the supposed teachings of Fleming, the Office Action states that "Fleming discloses advertisers paying rates based on viewing time ..." (See, Office Action, page 4, lines 9-10.) Yet, Claims 15, 16, 18, and 19 can not be so broadly construed.

Honey '553 shows a system for finding a mark within a video frame using pattern recognition (see, Col. 5, lines 12-16, and Col. 8, lines 30-39). Honey '553 further discloses that once the mark is found, it may be replaced with a replacement graphic from memory (see, Col. 9, lines 14-21). Nowhere within the four corners of Honey or Fleming is "[a] system for detecting and analyzing the presence of a logo, the system comprising a processor having input that receives at least one video datastream of an event, identifies one or more regions of interest (ROIs) for the logo in one or more images comprising the at least one datastream, analyzes the one or more ROIs to detect if the logo is present in at least one of the ROIs, and insures that an ROI having the logo is broadcast during the event for at least a total period of time corresponding to an associated advertiser's prepaid advertising" as required by Claim 15 disclosed or suggested. Honey does not even disclose or suggest measuring the time that the logo is present, nor is this a

consideration for Honey. Fleming can not even be modified to measure the time a logo is present since Fleming teaches monitoring a users interaction with a program to measure a time of use (see, Fleming, Col. 5, lines 14-53).

Additionally, Fleming even if somehow modifiable, does not disclose "analyzes the one or more ROIs to detect if the logo is present in at least one of the ROIs, and insures that an ROI having the logo is broadcast during the event for at least a total period of time corresponding to an associated advertiser's prepaid advertising" as required by Claim 15.

Accordingly, it is respectfully submitted that Honey '553 in view of Fleming clearly does not disclose or suggest the elements as required by Claim 15. Similarly, Honey '553 in view of Fleming does not disclose or suggest "[s]oftware stored on a computer readable medium for detecting and analyzing the presence of a logo, the software receiving as input digital representations of images that comprise at least one video datastream of an event, the software identifying one or more regions of interest (ROIs) for the logo in one or more images comprising the at least one datastream, analyzing the one or more ROIs to detect if the logo is present in at least one of the ROIs, and monitoring the presence of the logo

in the image when so detected, wherein the software provides an output regarding detection of the presence of the logo that is usable in insuring the broadcast of the logo during the event for a total accumulated time corresponding to paid for advertising of an advertiser" as required by Claim 18.

Based on the foregoing, the Applicants respectfully submit that independent Claims 15 and 18 are patentable over Honey '553 in view of Fleming and notice to this effect is earnestly solicited. Claims 16 and 19 respectively depend from one of Claims 15 and 18 and accordingly are allowable for at least this reason as well as for the separately patentable elements contained in each of said claims. Accordingly, separate consideration of each of the dependent claims is respectfully requested.

In addition, the Applicants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. The Applicants reserve the right to submit further arguments in support of the above stated position as well as the right to introduce relevant secondary considerations including long-felt but unresolved needs in the industry, failed attempts by others to invent the invention, and the like, should that become necessary.

Applicants have made a diligent and sincere effort to place this application in condition for immediate allowance and notice to this effect is earnestly solicited.

Early and favorable action is earnestly solicited.

Respectfully submitted,

By Gregory L. Thorne

Gregory L. Thorne, Reg. 39,398
Attorney for Applicant(s)
September 20, 2005

THORNE & HALAJIAN, LLP
Applied Technology Center
111 West Main Street
Bay Shore, NY 11706
Tel: (631) 665-5139
Fax: (631) 665-5101

CERTIFICATE OF MAILING

It is hereby certified that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to:

Mail Stop Amendment
COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

On September 20, 2005
(Date of Mailing)

By Gregory L. Thorne